

**THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Appellants: Andrea Hughs-Baird, et al.
Appl. No.: 10/086,014
Conf. No.: 3796
Filed: February 28, 2002
Title: GAMING DEVICE HAVING IMPROVED OFFER AND
ACCEPTANCE GAME WITH MASKED OFFERS
Art Unit: 3714
Examiner: Robert E. Mosser
Docket No.: 0112300-610

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANT'S SUPPLEMENTAL REPLY BRIEF

Sir:

Appellant submits this Supplemental Reply Brief in response to the Supplemental Examiner's Answer dated September 17, 2008 which was in response to Appellant's Reply Brief in response to the Examiner's Answer dated November 27, 2007 pursuant to 37 C.F.R. §1.193(b)(1). Appellant respectfully submits that the Supplemental Examiner's Answer dated September 17, 2008 (and the Examiner's Answer dated November 27, 2007) each failed to remedy the deficiencies of the Final Office Action dated October 13, 2006 as set forth in Appellant's Appeal Brief filed on March 9, 2007 (and in the Appellant's Corrected Appeal Brief filed on July 20, 2007). Accordingly, Appellant respectfully requests that the rejection of pending Claims 1 to 5, 8, 18 and 20 under 35 U.S.C. §102 be reversed and that the Board find the appealed claims patentable over the prior art of record.

Please charge deposit account number 02-1818 for any fees which are due in connection with this Supplemental Reply Brief.

I. STATUS OF CLAIMS

Claims 11 to 17, 21 and 22 stand allowed. Claims 6, 7, 9, 10 and 19 have been cancelled. Claims 1 to 10, 18 and 20 stand rejected. Therefore, Claims 1 to 5, 8, 18 and 20 are being appealed.

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 1 to 5, 8, 18 and 20 stand rejected under 35 U.S.C. §102(e) as being unpatentable over U.S. Patent No. 6,648,754 to Baerlocher et al. (referred to herein as "Baerlocher").

III. ARGUMENT

Accompanying the Reply Brief dated January 28, 2008, Appellant submitted an Amendment to Cancel Claims After Filing of Appeal Brief.

On March 19, 2008, the Examiner issued an Advisory Action After the Filing of an Appeal Brief in which the Examiner did not enter the Amendment to Cancel Claims. In this Advisory Action, the Examiner expressly stated that:

"The proposed cancel[l]ation of claims 6, 7, 9, and 10 would alter the claim scope of the language "directly and individually" in the remaining claims and ther[e]fore is improper for entry"

On April 1, 2008, Appellant's representative called the Examiner regarding a clarification of this Advisory Action. The Interview Summary of this telephone interview expressly stated that during this telephone interview, the Examiner and Appellant's representative:

[d]iscussed the Advisory Action mailed March 19th, 2008 and the denial of entry of the Appellant's reply brief based on the change in scope of the remaining claims resultant of the claim cancellation. Clarified with the Appellant that the decision to deny entry of the Appellant's brief was a Supervisory panel decision. No agreement was reached by the parties with regards to patentability, allowable subject matter, or specific language not previously addressed in the written record. In remaining discussion it was however agreed by the Examiner that the application of the prior art of Baerlocher would most likely cease to be relevant under the present interpretation if the proposed claim cancellation had occurred during normal prosecution. (emphasis added).

On April 9, 2008, Appellant filed a Petition under 37 C.F.R. §1.181 to Enter Filed Reply Brief and Amendment to Cancel Claims After Filing of Appeal Brief.

On May 22, 2008, this Petition was granted and the Amendment canceling Claims 6, 7, 9 and 10 was entered.

As a threshold question, Appellant questions why is the Examiner still maintaining the position that the prior art of Baerlocher anticipates Claims 1 to 5, 8, 18 and 20 when the Examiner expressly stated that the application of the prior art of Baerlocher would most likely cease to be relevant under the present interpretation if the proposed claim cancellation had occurred during normal prosecution.

Despite these statements, the Supplemental Examiner's Answer introduces new arguments related to Recitations of Intended Use for independent Claim 1.

Page 7 of the Supplemental Examiner's Answer stated that:

[t]he Appellant's claim 1 includes among other elements significant and notable utilization of intended use clauses including those directed to the intended operation of a processor that are not positively recited. For instance the clause "... a processor adapted to communicate with the display device and the input device, said processor operable to execute said instructions to operate with said display device and said input device, for each play of the game, to: ..." (Claim 1, lines 9-11) references the ability of the claimed invention and specifically the processor thereof "adapted to" communicate with the display device and an input device, "operable to" execute instructions, "operable with" a display device and "to" perform a series of program steps recited in claim lines 12-25. The above references do not limit the claim scope because they do not require the steps to be performed instead suggesting the ability of the device to perform steps rather than reflect the actual the execution of those steps (MPEP 21.11.04).

The Appellant's claim 1 further contains a "wherein" clause on line three of the same that additionally describes the intended use of offers being payable to the player without a positive recitation paying the offers to the player.

(B) ABSENT THE RECITATIONS OF INTENDED USE THE PENDING CLAIM LANGUAGE AND LIMITATIONS THEREOF ARE SIGNIFICANTLY REDUCED

The remainder of the claim language excluding the appellant's recitations of intended use direct the following:

A gaming device comprising:
a game including:
a plurality of offers(Element 100); and
a plurality of player selectable masked selections(Element 108);
a display device(Element 30,32);
an input device(Element 44);
a memory device storing a plurality of instructions(Element 40); and
a processor(Element 38).

Appellant respectfully disagrees with such a line of reasoning and submits that this is completely contrary to the law. Moreover, this new line of reasoning

regarding the gaming device of Claim 1, completely ignores the methods of operating a gaming device of Claims 18 and 20.

If such reasoning presented by the Examiner were correct, such reasoning would invalidate thousands of issued U.S. patents on computer related devices that are structurally similar, but differ in terms of how data is processed to produce different outcomes. The United States Supreme Court recently addressed this issue in discussing the distinction between hardware standing alone and hardware combined with software. *Microsoft Corp. v. AT&T Corp.*, 550 U.S. ____ (2007), 127 S. Ct. 1746. In *Microsoft Corp.*, the United States Supreme Court explained that once a piece of computer hardware was loaded with specialized software, the computer hardware was transformed to include the software's distinctive functionality that infringed a patented speech processor, while the hardware standing alone did not infringe. *Microsoft Corp.*, 127 S. Ct. at 1750. The software functionality gave patentable weight to the combined hardware and software and thus the software functionality had to be present for infringement to be found. Specifically, the United States Supreme Court stated:

AT&T's patent ('580 patent) is for an apparatus (as relevant here, a computer) capable of digitally encoding and compressing recorded speech. Windows, the parties agree, contains software that enables a computer to process speech in the manner claimed by the '580 patent. In 2001, AT&T filed an infringement suit in the United States District Court for the Southern District of New York, charging Microsoft with liability for domestic and foreign installations of Windows.

Neither Windows software (e.g., in a box on the shelf) nor a computer standing alone (i.e., without Windows installed) infringes AT&T's patent. Infringement occurs only when Windows is installed on a computer, thereby rendering it capable of performing as the patented speech processor.

Appellant further submits that the Court in *In re Lowry* held that:

[t]here is one further rationale used by both the board and the examiner, namely, that the provision of new signals to be stored by the computer does not make it a new machine, i.e. it is structurally the same, no matter how new, useful and unobvious the result. . . . To this question we say that if a machine is programmed in a certain new and unobvious way, it is physically different from the machine

without that program; its memory elements are differently arranged.

The fact that these physical changes are invisible to the eye should not tempt us to conclude that the machine has not been changed. 32 F.3d at 1583 (citing *Bernhart*, 417 F.2d at 1400) (emphasis added).

In other words, how a machine is coded provides structural differentiation from other machines. Appellant therefore submits that the Examiner may not ignore the features of the display device, the input device, the memory device and the processor of independent claim 1.

Moreover, the Federal Circuit has clearly held that a general purpose computer becomes a special purpose computer once it is programmed to perform particular functions pursuant to instructions from program software. *In re Alappat*, 33 F.3d 1526, 1545 (Fed. Cir. 1994). The Federal Circuit held that such programming of a general computer creates a new machine. *In re Alappat*, 33 F.3d at 1545. That is, computers including the same or similar hardware configurations that are coded in different ways (i.e., with software), creates specific purpose computers that are patentably different from each other. Thus, it must be the functionality of the software, or the functionality that the software gives the hardware which provides the patentability (i.e., the novelty and non-obviousness over the prior art). Accordingly, the Examiner's apparent view that Claim 1 is anticipated because only the hardware elements should be given patentable weight and the hardware is all essentially the same as the prior art is clearly not in accordance with the law of the United States Supreme Court and the Federal Circuit. Additionally, if the Examiner's assertions are proper, then the United States Patent and Trademark Office has been wrong on thousands of issued patents.

More specifically, courts have consistently provided patentable weight to actions claimed in a computer apparatus. In one such case, the Federal Circuit gave weight to features claimed in a computer program product claim when it analyzed whether Microsoft Corp. had infringed claims 1 and 6 of U.S. Patent 5,838,906 ("the '906 patent) with Microsoft Corp.'s web browser. *Eolas Tech. Inc. and The Regents of the U. of Ca. v. Microsoft Corp.*, 399 F.3d 1325 (Fed. Cir. 2005). Claims 1 and 6 of the '906 patent were directed to a method claim and a

computer program product claim, respectively. In particular, claim 6 was directed to a computer program product that included computer readable program code for causing a client workstation to run a browser application, and *inter alia*, parse hypermedia documents. In discussing the lower court's analysis of claims 1 and 6, the Federal Circuit noted that the "district court focused on claim 6 to interpret the claims because Eolas asserted that the computer program product in claim 6 embodies the method of claim 1." *Eolas*, 399 F.3d at 1330 (emphasis added). The Federal Circuit also stated that software and hardware as a process and a product are practically interchangeable in the field of computer technology. *Eolas*, 399 F.3d at 1339. Similarly, software as an operating element, drives the functional nucleus of the computer product, without which the invention would not work at all and not qualify as new and useful. *Eolas*, 399 F.3d at 1339. If the Federal Circuit had not given patentable weight to the software functions of the claimed computer program product, claim 6 would have been restricted to nothing more than a disc (i.e., the pure structure). Thus, the Federal Circuit in *Eolas* clearly accorded patentable weight to the nonstructural features claimed in the computer program product of claim 6.

In another example where the Federal Circuit accorded patentable weight to functions carried out by a computer, the *Akamai* Court construed the claimed actions of a plurality of machines in a distributed hosting framework. *Akamai Tech., Inc. and Mass. Inst. of Tech. v. Cable & Wireless Internet Services, Inc and Kenetech, Inc.*, 344 F.3d 1186 (Fed. Cir. 2003). In *Akamai*, the Federal Circuit considered whether U.S. Patent No. 6,185,598 anticipated claim 1 of U.S. Patent No. 6,108,703 ("the '703 patent") under 35 U.S.C. §102. Claim 1 of the '703 patent is directed to a distributed hosting framework operative in a computer network. The distributed hosting framework included numerous hardware elements and claimed how the software caused the hardware elements to interact. More specifically, the last clause of claim 1 claimed the process by which a client machine requests a web page and the other claimed structural elements of the distributed hosting framework interacted to provide the requested web page. In its anticipation analysis, the Federal Circuit focused on this interaction between the

separate structural elements of the distributed hosting framework to determine whether the hardware elements performed a specific task (i.e., whether the servers employed load balancing). *Akamai*, 344 F.3d at 1193. Based on the claimed actions of the hardware elements, the Federal Circuit determined that the specific task was not claimed. Thus, the Federal Circuit accorded patentable weight to the interactions that occur between the claimed structural elements to deliver a web page to a client machine. If the Federal Circuit had not accorded patentable weight to the claimed interactions between the structural elements, claim 1 of the '703 patent would have been nothing more than a number of connected hardware elements and simply read on any set of commonly networked computers. Thus, the Federal Circuit in *Akamai* clearly accorded patentable weight to the non-structural features of the distributed hosting framework of claim 1.

Similar to the computer apparatus type claims addressed in *Eolas* and *Akamai*, Claim 1 is directed to a gaming device. Similar to the computer related structures claimed in *Eolas* and *Akamai*, Claim 1 generally includes, amongst other elements, a display device, an input device, a memory device storing a plurality of instructions, and a processor adapted to communicate with the display device and the input device, the processor operable to execute the instructions to operate with the display device and the input device.

Moreover, similar to the interaction between structural elements given patentable weight by the Courts in *Eolas* and *Akamai*, the gaming device of independent claim 1 generally includes, amongst other elements, a display device, an input device, a memory device storing a plurality of instructions, and a processor adapted to communicate with the display device and the input device, the processor operable to execute the instructions to operate with the display device and the input device, for each play of the game, to: (a) directly and individually associate the offers with the selections, such that each offer is directly and individually associated with a separate one of the selections, (b) enable the player to select one of the selections, (c) reveal the offer directly and individually associated with the selected selection to the player, (d) enable the player to accept or reject the revealed offer, (e) repeat steps (a) to (d) at least once if the player

rejects the revealed offer, wherein if the player rejects the revealed offer, for the repeat of step (a) the revealed offer is directly and individually reassociated with one of the masked selections for at least one subsequent selection by the player; and (f) if the player accepts the revealed offer, pay the revealed offer to the player. Accordingly, all of the features of the gaming devices of Claim 1 (and dependent Claims 2 to 5 and 8) are steps to be performed and must be accorded patentable weight.

Moreover, Appellant respectfully reiterates the statements previously submitted in Appellant's Reply Brief dated January 28, 2008 regarding the words "directly" and "individually" as used in the claims. As previously stated by Appellant, such words have their ordinary and plain meaning. The context in which these words are used in the claims does not change their meaning. Rather, when viewed in their entirety, the claims reinforce the ordinary and plain meaning of the terms "directly" and "individually". Moreover, the Examiner's decision to focus on the definitions of the words "directly" and "individually" in the claims ignores Appellant's repeated clear and unequivocal statements made during the prosecution history of the present application regarding the direct and one-to-one relationship between the claimed offers and the claimed selections.

As Appellant's position is laid out in the Appellant's Reply Brief filed on January 28, 2008 and in the Appellant's Corrected Appeal Brief filed on July 20, 2007, Appellant will now address certain points raised by the Examiner in the Supplemental Examiner Answer.

1. In Appellant's Reply Brief filed on January 28, 2008, Appellant stated:

[b]y way of example, if the gaming device of independent Claim 1 includes the offers of 10 and 20 and also includes selection A and selection B, then to comply with the express language of the claims that "each offer is directly and individually associated with a separate one of the selections" one of two scenarios is possible. In the first scenario, selection A is associated with the offer of 10 and selection B is associated with the offer of 20. In the second scenario, selection A is associated with the offer of 20 and selection B is associated with the offer of 10. As illustrated in either of these two possible scenarios, the Examiner's contentions that the relationship between the offers and selections is a one-to-many relationship is unfounded. Accordingly, as each offer is directly and individually associated with

a separate one of the selections, the claim terminology clearly sets forth a one-to-one correspondence between the selections and the offers in the gaming device of independent Claim 1 and the method of operating a game of a gaming device of independent Claim 18.

On page 20 of the Supplemental Examiner's Answer, the Examiner stated:

[w]hile the Examiner does not contest that such arrangement would be fairly presented by such an example said example would not fairly represent the true scope the claim language. As shown below the claim language does not establish a two relationship it establishes a one way relationship wherein for each separate selection there is one offer directly and individually related to said selection. Continuing the appellant's example this would correlate to including an additional selection mapped to a common value as another selection.

Comparison of Appellant's Argued Scope Verses Actual Scope			
	Selection A	Selection B	Selection C
Appellant's 1 st Example	10	20	X
Appellant's 2 nd Example	20	10	X
Examiner's Example	10	20	10

Appellant submits that this example clearly ignores the express claim language that "each offer is directly and individually associated with a separate one of the selections."

Even if this example attempts to show that the offer of 10 is associated with a plurality of selections, Appellant submits that the first offer of 10 (that is associated with Selection A) is separate from the second offer of 10 (that is associated with Selection C). That is, while the offer associated with Selection A has a value of 10 and the offer associated with Selection C also has a value of 10, such offers are separate offers and even in the Examiner's example are each associated with a separate one of the selections.

Moreover, such an example appears to rely on the Examiner reverting back to a previously unsustainable position that the term "offer" and the term "value" are interchangeable. As submitted by Appellant in Responses to Office Actions filed

on January 19, 2006, February 22, 2006 and August 1, 2006, the specification fully supports Appellant's position that "offers" and "values" are not interchangeable, but rather are different terms with different interpretations. For example, page 13, line 8 to page 14, line 17 of the specification discloses that each player selectable selection has a value associated with it and not until the player picks one of the selections to reveal the associated value does the revealed associated value form the player's offer which the player may accept or reject. In another example, page 17, lines 3 to 5 of the specification discloses that "[a]fter the gaming device displays the value associated with the picked selection, the player may accept or reject the revealed value as their offer...". Thus, if only the value associated with the player's picked selection forms the player's offer which the player may accept or reject (and the remaining values not associated with the player's picked selection do not form the player's offer and thus the player may not accept or reject these values), when read in view of the specification, the term "value" and the term "offer" must have separate definitions with separate interpretations and are not interchangeable with respect to the pending claims. Additionally, page 14, lines 18 to 20 of the specification states that "...if the player rejects an offer, the value associated with that rejected offer is available for the gaming device to reassign or reassociate with another masked selection in subsequent rounds." That is, if a value is associated with a rejected offer and the value is available for a subsequent round, the term "value" and the term "offer" must have separate definitions with separate interpretations and are not interchangeable with respect to the pending claims.

2. In Appellant's Reply Brief filed on January 28, 2008, Appellant stated:

Appellant further submits that the Examiner's line of reasoning would render the terms "direct" and "directly" obsolete in not only claims pertaining to the computing arts, but also claims pertaining to the mechanical arts as well. For example, if a generic mechanical device claim states that "object A is directly connected to object B", the Examiner's line of reasoning would conclude that since matter still exists between object A and object B at the sub-atomic level, the two objects are not directly connected despite the express language of

the claim. Similarly, if a generic computing device claim states that "object A is directly associated with object B", the Examiner's line of reasoning would conclude (as is this case with Claim 1), that since object A is associated with data which is mapped onto data associated with object B, the two objects are not directly associated with each other, despite the express language of the claim. Such conclusions are contrary to the ordinary and plain meaning of the term "directly" and inherently flawed. Accordingly, when each of the four uses of the term "directly" in Claim 1 is read in context of the specification and is further given its ordinary and plain meaning, a direct relationship between the offers and the selections (without any intervening elements) clearly exists.

In responding to this example, on pages 22 to 23 of the Supplemental Examiner's Answer, the Examiner stated:

[t]he appellant's arguments as crafted present and argue the language "directly connected" in a clear shift away from the claim language of directly associate[d]. The arguments following therefrom attempt to argue that the examiner's reasonability or alleged lack thereof based on the connotation of the term *connected* rather than *associated*. Never the less to continue the appellant's line of reasoning: A computer may be directly connected to a monitor through a video cable. Nothing in the phrase "directly connected" would invalidate this assessment under to the broadest reasonable interpretation because even if the language was intended to preclude any intervening elements the languages fails to address such elements. The same would follow through to the actual claim language (directly associate) because the language presents a correspondence between the selections and the offers without positively reciting that there is an absence of intervening elements between the selection and the offer.

To clarify, Appellant was not equating the term "connected" to the term "associated" but was merely illustrating an extreme example of the Examiner's line of reasoning. Nevertheless, the Examiner's statement regarding the pending claims not positively reciting that there is an absence of intervening elements between the selection and the offer would require Appellant to define Appellant's present invention not by claiming what the present invention is, but rather by claiming what Appellant's present invention is not.

For at least the forgoing reasons, Appellant respectfully submits that the Supplemental Examiner's Answer does not remedy the deficiencies noted in

Appellant's Corrected Appeal Brief with respect to the Final Office Action and Appellant's Reply Brief. Therefore, Appellant respectfully once again requests that the Board of Appeals reverse the rejection of Claims 1 to 5, 8, 18 and 20 under 35 U.S.C. §102(e) and find that these claims are patentable over the prior art of record.

Respectfully submitted,

BELL, BOYD & LLOYD LLP

BY



Adam H. Masia
Reg. No. 35,602
Customer No. 29159

Dated: November 13, 2008